

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 42

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

JUN 27 2003

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAKANOBU KAMAKURA

Appeal No. 1999-1627
Application No. 08/578,980

RECEIVED: 7/3/03
OBLON, SPIVAK, McCLELLAND
MAIER & NEUSTADT, P.C.

DOCKETING DEPT
Initials/Date Docketed: 8/7/03
Type of Resp(s): Appeal to CAFC / Rehearing
Due Date(s): 8/27/03 (Final)

Before JERRY SMITH, RUGGIERO,¹ and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is in response to appellant's request that we reconsider our decision mailed February 19, 2002, wherein we sustained the final rejection of claims 1-10. However, appellant's arguments fail to convince us that we erred in any respect in the decision. We therefore decline to make any changes therein.

¹ Administrative Patent Judge Lali retired from the USPTO before this case was reached for rehearing. Legal support for substituting one Board member for another can be found in In re Bose Corp., 772 F.2d 866, 869, 227 USPQ 1, 4 (Fed. Cir. 1985).

Appellant reargues a point that we addressed on page 4 of the opinion, in which we noted that the instant claims do not preclude reading layers 31, 29, and that portion of layer 25 between strain layer 27 and active region 29 (Scifres Fig. 2) as the hetero-configuration light emitting device. Appellant appears to hold that, because Scifres refers to both portions of layer 25 surrounding strain layer 27 as "cladding layer 25," the artisan would not have considered a combination that includes the uppermost portion of layer 25 as meeting the terms of the claims.

For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference, but this is not an "ipsissimis verbis" test. In re Bond, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). The claims measure the invention. SRI Int'l v. Matsushita Elec. Corp., 775 F.2d 1107, 1121, 227 USPQ 577, 585 (Fed. Cir. 1985) (en banc). In view of 12 appellant's choosing to draft the claims in an open-ended, "comprising" form, we are not persuaded of error in our determination that the elements set forth as in instant claim 1, under the broadest reasonable interpretation of the terms, fail to distinguish over the structures disclosed by Scifres. The reference describes distinct portions of 13 layer 25 separated by strain layer 27. The claims are sufficiently broad to read on the portion of layer 25 between the strain layer and the active region as depicted in Figure 2 of the reference.

Contrary to appellant's indication in the request, we did not ignore any description in Scifres that provides "a distance of 0.05µm as to that part of 25 that is

between 27 and 29" and that the reference indicates "cladding layer thicknesses to be typically about 1 μ m." Scifres teaches that strain layer 27 in Figure 2 is typically at least 0.5 μ m away from the active region. Col. 5, ll. 16-24. The reference's teaching with respect to the 0.5 μ m distance thus indicates a lower bound for distance of the strain layer from the active region, rather than a requirement of 0.5 μ m distance. Moreover, the cladding layer thicknesses described as "typically about 1 μ m thick" refer to cladding layers 13 and 17 in the separate embodiment of Figure 1. Col. 3, ll. 39-56.

We thus were, and remain, unconvinced that the relevant Scifres structures shown in Figure 2 do not fall within the broad terms of "approximately equal layer thickness" as recited in instant claim 1. Scifres' Figure 1 shows layers 13 and 17 equal in thickness, consistent with the written description at column 3, lines 55 and 56 of the reference. Appellant's arguments as to why we should consider the relevant layers of Figure 2 as something different from "approximately equal layer thickness" are contrary to an appreciation of all the teachings of the reference. Moreover, whether the reference teaches the relevant layers as being of "equal" layer thickness is not at issue, in view of appellant's choice of language setting forth the alleged distinction.

Appellant also alleges that we disregarded claim language, in view of our opinion not quoting all relevant limitations at the top of page 5. We did not disregard limitations, but simply referred to the relevant limitations -- using fewer than all the words -- by speaking of the Scifres structure as protecting the hetero-configuration from crystal defects "as claimed" (emphasis added). As for the asserted lack of explaining our

Appeal No. 1999-1627
Application No. 08/578,980

reasoning, we direct attention to page 4 of the opinion where we referred to the examiner's specific findings in the Answer, and noted the broadening language of claim 1 relative to crystal defects, neither of which appellant has shown to represent error.

Appellant also submits that we erred in failing to denominate the affirmance as a new ground of rejection, as provided for by 37 CFR § 1.196(b). A rejection must be considered "new" if the appellant has not had a fair opportunity to react to the thrust of the rejection. In re Kronig, 539 F.2d 1300, 1302, 190 USPQ 425, 426 (CCPA 1976).

We believe it apparent that our reference to appellant's description of the prior art in the instant disclosure did not represent a new finding necessary for affirming the rejections, but merely pointed out that appellant's record is inconsistent with a position advanced in the brief.

Contrary to appellant's implication, we do not consider our finding at page 6 of the opinion that Scifres taught "a second dense defect layer," and that the teaching of Inoue for the addition of a second dense defect layer could be considered merely cumulative, as changing the thrust of the rejection. That the references taught a second dense defect layer as claimed was the thrust of the rejection applied against claims 2 and 8. Moreover, we did not disagree with the examiner's findings with respect to the teachings of the respective references.

Finally, appellant asserts that the decision made "no attempt" to answer the "specific arguments" at pages 14-15 of the brief in defense of claim 8. The answer to the arguments is found at page 7, first full paragraph of the opinion, where we pointed

Appeal No. 1999-1627
Application No. 08/578,980

out that appellant's reasoning was based on the alleged disparity in teachings between the Inoue and Scifres references. We further pointed out that, for the same reasons with respect to why we found the combination of Scifres and Inoue as applied against claim 2 to be proper, we found appellant's position with respect to claim 8 to be untenable.

We have thus granted appellant's request to the extent of reconsidering the decision mailed February 19, 2002. However, we deny the request with respect to making any changes therein.

Appeal No. 1999-1627
Application No. 08/578,980

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

DENIED

Jerry Smith
JERRY SMITH

Administrative Patent Judge

Joseph F. Ruggiero
JOSEPH F. RUGGIERO

Administrative Patent Judge

Howard B. Blankenship
HOWARD B. BLANKENSHIP

Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)

Appeal No. 1999-1627
Application No. 08/578,980

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA , VA 22314

The United States Patent and Trademark Office has changed certain mailing addresses!

Effective May 1, 2003

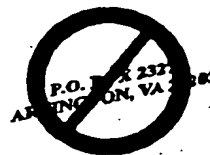
Use the address provided in this flyer after May 1, 2003 for any correspondence with the United States Patent and Trademark Office (USPTO) in patent-related matters to organizations reporting to the Commissioner for Patents.

DO NOT USE the Washington DC 20231 and P.O. Box 2327 Arlington, VA 22202 addresses after May 1, 2003 for any correspondence with the USPTO even if these old addresses are indicated in the accompanying Office action or Notice or in any other action, notice, material, form, instruction or *other* information.

Correspondence in patent-related matters to organizations reporting to the Commissioner for Patents must now be addressed to:



**Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**



Special Mail Stop designations to replace Special Box designations

Also effective May 1, 2003, the USPTO is changing the special Box designations for Patents and Trademarks to corresponding Mail Stop designations (e.g., "Box 4" will now be "Mail Stop 4").

For further information, see *Correspondence with the United States Patent and Trademark Office*, 68 Fed. Reg. 14332 (March 25, 2003). A copy of the *Federal Register* notice is available on the USPTO's web site at <http://www.uspto.gov/web/menu/current.html#register>

A listing of specific USPTO mailing addresses (See Patents – specific) will be available on the USPTO's web site on April 15, 2003 at <http://www.uspto.gov/main/contacts.htm>

Persons filing correspondence with the Office should check the rules of practice, the Official Gazette, or the Office's Internet Web site (www.uspto.gov) to determine the appropriate address and Mail Stop Designation (if applicable) for all correspondence being delivered to the USPTO via the United States Postal Service (USPS).

Questions regarding the content of this flyer should be directed to the Inventor Assistance Center at (703) 308-4357 or toll-free at 1-800-786-9199.

NOTICE

Board of Patent Appeals and Interferences Mail Effective May 1, 2003

Appeals

All correspondence in an application involved in an appeal to the Board of Patent Appeals and Interferences during the period from when an appeal docketing notice is issued until a decision has been rendered by the Board of Patent Appeals and Interferences as well as any hearing confirmations, waivers and requests for rehearing of a decision by the Board of Patent Appeals and Interferences should be mailed to:

**Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450**

Notices of appeal, appeal briefs, reply briefs, requests for oral hearing should be addressed to:

**Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

Interferences

All mail to the Board relating to patent interferences should be sent to the following address unless an administrative patent judge or the Board specifically requires the use of a different address after May 1, 2003:

**Mail Stop INTERFERENCE
Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450**

Any inquiries regarding the content of this notice should be directed to a Program and Resources Administrator of the Board of Patent Appeals and Interferences at (703) 308-9797.